

REMARKS

The Office Action dated December 16, 2004, has been received and reviewed.

Claims 1-23 are currently pending and under consideration in the above-referenced application, each standing rejected.

Reconsideration of the above-referenced application is respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-12 and 14-23 stand rejected under 35 U.S.C. § 103(a).

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Klun in View of Zimmer

Claims 1-12 have been rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over the subject matter taught in U.S. Patent 5,667,541 to Klun (hereinafter "Klun"), in view of teachings from U.S. Patent 6,054,183 to Zimmer et al. (hereinafter "Zimmer").

Klun teaches processes for forming abrasive articles. The abrasive articles that are taught by Klun include abrasive particles that are dispersed throughout a cured polymer. *See, e.g.*, FIGs. 1 and 2; col. 13, lines 27-30. Klun does not teach or suggest use of the abrasive articles in conditioners for polishing pads.

The teachings of Zimmer are directed to conditioners for polishing pads. A conditioner according to the teachings of Zimmer includes a substantially uniform layer of diamond particles

that have been secured to a substrate (*see, e.g.*, FIGs. 4, 9E, 11; col. 2, lines 45-51; col. 4, lines 21-26), as well as a chemical vapor deposited layer of diamond over the diamond particle-bearing surface of the substrate (*see, id.*). Zimmer highlights the importance that the monolayer of diamond particles be *highly uniformly distributed* by indicating that a pad may be conditioned *very uniformly*. Col. 9, lines 1-16; FIGs. 10 and 11. In fact, a large part of the disclosure of Zimmer is dedicated to a description of various techniques for forming a highly uniform monolayer of diamond particles on a substrate. Col. 4, line 21, to col. 8, line 67; col. 10, line 24, to col. 16, line 20; FIGs. 3-9E.

A *prima facie* case of obviousness cannot be established against the claims of the above-referenced application based merely upon the teachings of Klun and Zimmer. More specifically, one of ordinary skill in the art would not have been motivated to combine the teachings of Klun and Zimmer in the manner that has been asserted. This is because the abrasive articles taught in Klun include abrasive particles that are homogenously distributed randomly throughout a polymer, whereas the teachings of Zimmer are strictly limited to conditioning apparatus that include abrasive particles in highly uniform monolayers. The techniques that are taught in Klun would not be useful for forming conditioners of the type disclosed in Zimmer since the abrasive articles of Klun lack the monolayer abrasive particle that is so important to the conditioners taught in Zimmer. In view of this disparity between the teachings of Klun and those of Zimmer, it appears that the only motivation for one of ordinary skill in the art to combine the teachings of these references in the manner that has been asserted would have been improper hindsight reliance upon the disclosure of the above-referenced application.

As the teachings of Klun and Zimmer cannot be relied upon to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), withdrawal of the 35 U.S.C. § 103(a) rejections of independent claim 1, and of claims 2-12 depending therefrom, is respectfully solicited.

Claim 10 is also allowable under 35 U.S.C. § 103(a) because Klun and Zimmer both lack any teaching or suggestion of a method that includes forming a supporting substrate from a quantity of abrasive material.

Klun, Zimmer, and Bange

Claims 14-23 are rejected under 35 U.S.C. § 103(a) for reciting subject matter which is purportedly unpatentable over the teachings of Klun, in view of teachings from Zimmer and, further, in view of the subject matter taught in U.S. Patent 6,352,471 to Bange et al.

Claims 14-23 are each allowable, among other reasons, for depending either directly or indirectly from claim 1, which is allowable.


Allowable Subject Matter

The indication that claim 13 recites allowable subject matter is gratefully acknowledged. This claim has not been amended to independent form, as the claims from which it depends are believed to be allowable.

CONCLUSION

It is respectfully submitted that each of claims 1-23 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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